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| 09/747,817      | 12/22/2000  | Rommel C. Lumaig     | ACSC 60133 (2109)   | 4301             |

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EXAMINER

PELLEGRINO, BRIAN E

ART UNIT PAPER NUMBER

3738

DATE MAILED: 01/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/747,817

Applicant(s)

LUMAUIG, ROMMEL C.

Examiner

Brian E Pellegrino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 October 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 17-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Election/Restrictions*

Claims 17-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 7.

### *Drawings*

The drawings are objected to under 37 CFR 1.83(a) because they fail to show where the transverse cross section "10-10" is taken from Fig. 8 as described in the specification, page 5, lines 10,11. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Specification*

The disclosure is objected to because of the following informalities: On page 4, line 17, the description should read —Fig. 4—not "Fig. 3."

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,9-12,15 are rejected under 35 U.S.C. 102(b) as being anticipated by Miraki (5951513). Fig. 3 shows a balloon catheter with an outer tubular member **20a** and an inner tubular member **22a** with the tubular members being partially attached by two junctures **24a**. Claims in a pending application are given their broadest reasonable interpretation, In re Hyatt, 211 F.3d 54 USPQ2d 1664 (Fed. Cir. 2000). A juncture is interpreted as something providing means to join two things. Fig. 2 shows the elongated shaft with inflation lumen **23a** and the junctures are located along the same length of the catheter. Fig. 1 shows the catheter system with cross section 3-3 taken proximal to the balloon, this is the view for Fig. 3. It can also be seen that the balloon **14a** is on the distal shaft section. With respect to claim 12, Fig. 3 is a symmetrical view, thus the junctures are disposed equal distance from one another. The balloon is fully capable of being configured for a stent.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Songer et al. (4892519). Claims in a pending application are given their broadest reasonable interpretation, In re Hyatt, 211 F.3d 54 USPQ2d 1664 (Fed. Cir. 2000). In this instance the balloon end is interpreted as ending where it is not inflatable or where the openings begin. Thus, it can be interpreted that the balloon catheter has an outer tubular

member **12** with an inner tubular member **11** partially attached at a juncture shown in Fig. 4. Songer et al. disclose the bonding of the tubular members is for a distance of 100-120mm and that the openings spaced within the bonded area are 80-100mm, col. 3, lines 1-24. As a result of the openings, some of the juncture is not bonded. This results in a difference in longitudinal dimension that falls within the claimed range of 1-4mm. Fig. 2 shows the inner tube has a lumen for a guidewire **24**. Fig. 1 shows the balloon **17** positioned on the distal shaft section.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Songer et al. '519. Songer et al. is explained supra. However, Songer does not disclose the juncture having a radial dimension ranging 1-2mm or spacing the juncture from the balloon proximal end about 1mm. It would have been an obvious matter of design choice to use a radial dimension for the junctures, since applicant has not disclosed that the radial juncture dimension provides any advantage or solves any stated problem or is used for any particular purpose. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either the radial juncture dimension taught by Songer et al. or the claimed range 1-2mm,

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because both radial dimensions still function to attach or bond the tubular elements together. Regarding claims 7,8 it would have been an obvious matter of design choice to space the junctures a range of 1-3mm from the balloon, since applicant has not disclosed that the spacing provides any advantage or solves any stated problem or is used for any particular purpose. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either the spacing taught by Songer et al. or the claimed range 1-3mm, because both spacings still separate the expansion area from the inflation area.

Claims 13,14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Songer et al. '519 in view of Muni et al. (5533968). Songer et al. is explained supra. However, Songer does not disclose the outer and inner tubular members being made of different materials. Muni et al. teach that outer and inner tubular members of a balloon catheter are made of different material and are bonded by heat, col. 11, lines 16-32. It would have been obvious to one of ordinary skill in the art to use different materials for the tubular members as taught by Muni in the balloon catheter of Songer in order to strengthen the bond.

Claims 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Songer et al. '519 in view of Brown (6096056). Songer et al. is explained supra. However, Songer does not disclose the use of a stent on the intermediate portion of the balloon. Brown teaches (Fig. 3) a stent **18** on a balloon catheter in the intermediate region. The intermediate region is interpreted as the expanding portion. It would have been obvious

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to one of ordinary skill in the art to use a stent with the balloon catheter of Songer et al. in order to provide a patient with a device to maintain the vessel lumen.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Pellegrino whose telephone number is (703) 306-5899. The examiner can normally be reached on Monday-Thursday from 9am to 6:30pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached at (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-2708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Brian Pellegrino

TC 3700, AU 3738

24-December-02

*Brian E Pellegrino*



Bruce Snow

Primary Examiner